



In The United States Patent And Trademark Office

Applicant: Farah D. Morton **Examiner:** Hewitt, James M.
Serial No. 10/716,247 **Filed:** 11/17/2003
For: Portable Infant Bed **Group Art Unit:** 3679
Docket: 4460

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMMENTS OF APPLICANT ACCOMPANYING
INFORMATION DISCLOSURE STATEMENT (IDS)

It is believed that some explanation may be helpful to the examiner as to the timing of submission of this IDS, and as to the large number and possible relevancy of the prior art citations in the IDS.

As background, the prosecution history of this reissue application establishes that this application was prepared and initially prosecuted by attorney Mark D. Miller, until May 18, 2006 (a date subsequent to the date of abandonment of the application), when the undersigned, Harris Zimmerman, was substituted as attorney of record. Mr. Miller is also the attorney who prepared and prosecuted the application resulting in Patent 6,370,715, which is the original patent on which this reissue is based. Mr. Miller and his law firm, Kimble, MacMichael & Upton, also represented Farah D. Morton and her company, Baby Delight, Inc. in an action brought against The First Years, Inc. for infringement of said original Patent 6,370,715. This patent litigation is made of record in the reissue proceeding.

A controversy has arisen between Ms. Morton and her company on the one hand and Mr.

Miller and his firm on the other hand regarding Mr. Miller's handling of the preparation and prosecution of Patent 6,370,715 and of the conduct of Mr. Miller and his law firm in the filing and prosecution of the patent infringement action against The First Years, Inc.

Pursuant to certain retention agreements entered into by Farah D. Morton and Baby Delight, Inc. ("Claimants") and Mark D. Miller and Kimble, MacMichael & Upton ("Respondents"), Claimants formalized their claims against Respondents for negligent conduct and malpractice by demanding arbitration before the American Arbitration Association. This arbitration is now pending under Case No. 74Y19416906JISI, *Farah D. Morton, et al. v. Mark D. Miller, et al.*

As a result of this controversy between claimants and Respondents, a conflict of interest arose in connection with this pending reissue application which caused Mr. Miller to withdraw from further representing Claimants in this matter.

After this controversy between Claimants and Respondents arose, a law firm engaged by Respondents in this matter advised the law firm engaged by Claimants that a patent expert or consultant had been engaged by Respondents. Pursuant to an order on procedure in the arbitration, the identification of the expert and the expert's opinions on any patent issues is not yet due.

However, in early January 2008, Respondents' counsel advised Claimant's counsel that its expert/consultant made a "comprehensive prior art investigation ... and it certainly appears that a fixed wall sleeper would have been invalid.... It also appears that a detachable wall sleeper would also be invalid". Respondents' counsel further advised Claimants that they believe this information (the prior art and information) could have a material adverse impact on Claimants' pending petition to revive the reissue application. Respondents further stated that such prior art

"may result in a determination that either Claimants' reissue application will be denied because the new claim of a fixed wall is not sufficiently new or it may even bear on the validity of the entire patent."

At the request of and motion by Claimants' counsel, the Arbitrator handling said controversy issued an order dated January 15, 2008, as follows:

"1. Counsel for Respondent will provide Counsel for Claimant via e-mail by 5:00 p.m. January 16, 2008, a list of the items of 'prior art' that have been identified to date by Respondents Counsel or Counsel's consultants and experts that could have an adverse impact on Claimant's pending application to revive the reissue application." (Emphasis added)

The list supplied by Respondents' counsel pursuant to such order had a number of duplications, and what appeared to be patents unrelated to baby beds. On January 22, 2008, Respondents' counsel advised Claimants' counsel:

"What we have and what we have provided to you is a list of prior art that a number of prior art searches uncovered. As a result each could theoretically impact the pending reissue patent. By the time of the disclosure neither our consultants nor our expert had sorted through them with the intent of screening out less probative information. I do not have a report or indication of what prior art our experts will ultimately rely upon.

Accordingly, the purpose of my email was to give you a heads up that you and Mr. Zimmerman may reach an independent determination that some of the prior art we have disclosed is not relevant to you [sic] pending application. I leave that to you. In short, I have nothing further to disclose at this time."
(Emphasis added)

Such communication posed a problem for me, as the current prosecuting attorney in the reissue application. Pursuant to my duty to disclose information material to patentability (37 C.F.R. §1.56) and MPEP 2052, I wanted to determine what prior art was in fact believed by Respondents and their expert/consultant to have a material impact on the reissue application.

On January 25, 2008, the Arbitrator, upon motion by Claimants, issued a further order

regarding that a corrected list be given to Claimants of prior art that could have an adverse impact on Claimants' reissue application.

The items listed in the attached IDS comprises the "corrected list" supplied by Respondents' counsel. The corrected list includes 83 patents, and the "prosecution history of U.S. Patent Application No. 11/246,968 and references therein". There are 12 such references. The undersigned is not too clear on how the prosecution history of a pending patent application constitutes prior art, but as a cautionary measure, a copy of such prosecution history was ordered and is enclosed herewith as the 84th item. The 12 references are listed following and constitute items 85-96.

With this background, since it appears that Respondents, if properly complying with the Arbitrator's order, contend that each of the citations has an "adverse impact" in Claimants' reissue application, I felt it necessary to list all citations in the enclosed IDS, irrespective of their patent dates, their subject matter, or the like.

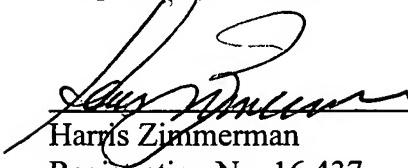
MPEP 2004 (10) makes it clear that:

"When in doubt, it is desirable and safest to submit information. Even though the attorney, agent, or applicant doesn't consider it necessarily material, someone else may see it differently and embarrassing questions may be avoided...."

Counsel regrets that Respondents' defense to a claim for negligent conduct and malpractice has come up at this time with its added burden on the examiner.

Dated: January 30, 2008

Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 30, 2008.

Date: January 30, 2008


Jennifer L. Lynx